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B. C. Hill
Attorney for Applicant

PATENT

Client No. SJ0920000160US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

Applicant: Jeffrey S. Lille

Serial No.: 09/933,218

Filed: August 20, 2001

For: ELECTRO-THERMAL MICROMECHANICAL)
ACTUATOR FOR FINITELY POSITIONING A)
STORAGE DEVICE SLIDER AND METHODS OF USE)
AND MANUFACTURE)

Examiner: Jason C. Olson

FEB 03 2004

Technology Center 2600

Group Art

Unit: 2651

ELECTION

The Honorable Commissioner of Patents
and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office action mailed December 2, 2003, the following is submitted:

ELECTION

Claims 1-24 were originally presented upon filing of the present application and were the subject of a restriction requirement. The Examiner restricted the claims into the following groups: Group I claims 1-10, drawn to a method of making a micromechanical actuator, Group II claims 11-19, drawn to a micromechanical actuator, and Group III claims 20-24, drawn to a method of track centering. Applicant respectfully traverses this restriction requirement and requests reconsideration under 37 CFR §1.143 in view of the following reasons. Applicant provisionally elects Group II claims 11-19 in the event that the restriction requirement is not withdrawn.

The Examiner asserts that Groups I and II are related as a process of making and product made. The Examiner asserts that these inventions are distinct under MPEP §806.05(f) because the claimed process can be used to make a materially different product such as electrical circuits.

Applicant respectfully disagrees. The proper test for distinctiveness under MPEP §806.05(f) requires that:

“A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process.” MPEP §806.05(f) Italics added.

The Examiner presents only one portion of the two part test under (A) above. In addition to “the process as *claimed* be[ing] used to make other and different products,” the process as claimed must not be an obvious process of making the product. The Examiner has failed to address this requirement. Applicant asserts that the process set forth in claim 1, as claimed, is clearly an obvious process of making the product. The Examiner is referred to claims 1 and 11 where the difference is essentially that the elements of claim 11 include gerunds relating to a process appended to them in claim 1. Therefore, Applicant asserts that the process *as claimed* is an obvious process of making the product.

In addition, Applicant asserts that the product can not be made by a materially different process because the process steps recited, are steps necessary to define the product. An alleged

materially different process would necessarily not include the same steps are the process recited in claim 1. Therefore, the alleged materially different process would not result in the product. Therefore, Applicant respectfully asserts that Groups I and II are related and not distinct. Applicant respectfully requests withdrawal of the restriction request.

The Examiner asserts that Groups II and III are related as subcombinations disclosed as useable together in a single combination are *usually* distinct from each other. The Examiner asserts that these "subcombinations" are distinct under MPEP §§806.04, 808.01 because invention ^{III} II has separate utility, namely track centering.

Applicant respectfully disagrees. The proper test for distinctiveness under MPEP §806.05(d) requires that there be at least two subcombinations. A subcombination is an element of a combination. MPEP §806.05(c). Applicant asserts that Group III is not a subcombination because this invention is not an element of another combination. In other words, there is no generic claim that encompasses both Groups II and III. MPEP §806.05(d) indicates that "care should be exercised...to determine if the several subcombinations are generically claimed." Such care is advised because if there is a generic claim, then a restriction requirement may be more appropriate. However, where there is clearly no generic claim encompassing Groups II and III, Applicant respectfully asserts that a restriction requirement is improper because one group, Group III is not a subcombination. MPEP §806.04(d).

Instead, Applicant respectfully asserts that Group III is a combination that includes the essential subcombination of Group II. MPEP §806.05(c)II. The method of Group III is well known but for the positioning features provided by the subcombination of Group II, the micromechanical actuator. Therefore, as indicated in MPEP §806.05(c)II a restriction requirement is improper where the subcombination, Group II, is essential to the combination.

Furthermore, Applicant asserts that Groups II and III are properly related as a product and a process of using the product under MPEP §806.05(h). These groups are not distinct because the process of using, the micromechanical actuator, Group II can NOT be practiced with another materially different product. MPEP §806.05(h)(A). Applicant knows of no replacement "electro-thermal micromechanical actuator" that may be used in place of the product in Group II to position a read/write slider over the centerline of the read/write track of a storage device. In

addition, the Examiner has provided no evidence of a materially different product that may replace the product of Group II.

These groups are not distinct because the product as claimed can NOT be used in a materially different process. MPEP §806.05(h)(B). In particular the product comprises a read/write slider, movable member, and electro-thermal actuator element. Together these elements form a micromechanical actuator which must be used in a process of "operation of a positioning system of a storage device," Group II. Therefore, Groups II and III are not distinct. Applicant respectfully requests that the restriction requirement regarding Groups II and III be withdrawn.

The Examiner asserts that Groups I and III are unrelated. Applicant respectfully disagrees.

Applicant asserts that Groups I and III are related because Groups I, II and ~~III~~ are related as a product, a method of making the product, and a process of using the product under MPEP §806.05(i). Groups I and II are related as a product and method of making the product that are not distinct under MPEP §806.05(f) as explained above. Groups II and III are related as a product and a process of using under MPEP §806.05(h) as explained above.

MPEP §806.05(i) recites:

Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required *only where the process of making and the product made are distinct* (MPEP § 806.05(f)); otherwise, the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using (MPEP § 806.05(h)). Italics added.

By asserting that Groups I and II are related under MPEP §806.05(f), the Examiner has established a relationship between Groups I and II. The Examiner, however, has failed to prove that the process of making, Group I, and the product made, Group II, are distinct, as explained above. Therefore, a restriction requirement is improper because "the process of using must be joined with the process of making and product made, even if a showing of distinctness can be made between the product and process of using." MPEP §806.05(i).

A restriction requirement may be issued prior to a decision regarding patentability of the product. *Id.* Because a decision regarding the allowability of the product claims, Group II, has

not yet been made and a proper restriction requirement of the process of making and process of using the product depends on such a decision, Applicant requests that this restriction requirement be withdrawn until a decision regarding the patentability of the product claims, Group II, is made.


Furthermore, Applicant disagrees that Group I would be classified in class 29, subclass 603.04. Group I is directed to forming a movable member having an electro-thermal actuator element coupled to a read/write slider. Class 29, subclass 603.04 relates to "process wherein a premanufactured recording head or core is assembled or permanently associated with additional parts or components." Group I forms the parts and components in a read/write slider but does not assemble or permanently associate the read/write slider with additional parts or components. Applicant asserts that Group I properly comes under class 360. Thus, because groups I, II, and III are properly classified under class 360, Groups I, II, and III are sufficiently related and non-distinct such that a restriction requirement is improper.

Therefore, in view of the remarks above, Applicant respectfully asserts that restriction of claims 1-24 into Groups I, II, and III is improper. Applicant respectfully requests that the restriction requirement be withdrawn.

In accordance with 37 CFR §1.143, Applicant hereby elects the claims of Group II, namely claims 11-19.

Dated this 27 day of January 2004.

Respectfully submitted,


Brian C. Kunzler
Reg. No. 38,527
Attorney for Applicant

Date: January 27, 2004

KUNZLER AND ASSOCIATES
8 E. Broadway Suite 600
Salt Lake City, UT 84111
Telephone: 801/994-4646

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